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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,787	10/17/2003	Sergio Rossi	4235.409	7723

7590 04/03/2006

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EXAMINER

NGUYEN, DONGHAI D

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 04/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/686,787	Applicant(s) ROSSI, SERGIO	
	Examiner Donghai D. Nguyen	Art Unit 3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on 12 January 2006 has been considered and made of record.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 13-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "preferably" (claim 13, line 3) and "optionally" (claim 13, line 4) renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

"assembling said bars inside a copper shell in an assembly of predetermined configuration" (claim 13, lines 6-7) is vague and confusing. It is referred to revise the step as: -- assembling said bars inside a copper shell to form an assembly having predetermined configuration--.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 24 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 4,860,431 to Marancik et al or US Patent 43,686,750 to Woolcock.

Marancik et al disclose a superconducting NbTi cable (NbTi alloy see Col. 2, lines 66-68) comprising: bars having a core (Nb) defined by a mono- or multifilament of superconducting material (NbTi alloy see Col. 2, lines 66-68), a copper sheath (Col. 3, lines 1-3) and a barrier layer of noble metal or metal alloy (Col. 3, lines 3-6) interposition between the core and the sheath; said bars are assembled inside a copper shell to form an assembly and subjecting the assembly to a number of successive plastic deformation steps by solely cold plastic deformation (Col. 2, lines 41-46).

Woolcock et al disclose a superconducting NbTi cable from bars comprising a core (Nb 10 see Fig. 1) defined by a mono- or multifilament of superconducting material (NbTi alloy 12 see Col. 2, lines 32-33), a copper sheath (13), and a barrier layer of noble metal or metal alloy (Col. 4, lines 14-19) interposition between the core and the sheath; and said bars are assembled inside a copper shell to form an assembly (Fig. 1) wherein the assembly are subjected to a number of successive plastic deformation (Col. 2, lines 44-48) steps by solely cold plastic deformation (at room temperature Col. 3, lines 47-50).

Since Marancik et al or Woolcock et al disclose a superconducting NbTi cable having all structural elements recited in claim 13 and formed by solely cold plastic deformation, cable must have a relatively high critical current as claimed by Applicant.

Allowable Subject Matter

6. Claim 13 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.
7. Claims 14-23 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed 12 January 2006 regarding product by process claim 24 have been fully considered but they are not persuasive.

Applicant argues that Marancik and Woolcock et al do not teach product as recited in claim 24, a superconducting NbTi cable obtained solely through cold drawing operations (see "Remarks" pages 10 and 11, 2nd paragraph). The Examiner disagrees because the above subject matter is taught by each of the applied reference and being discuss at Col. 2, lines 41-46 of Marancik and/or Col. 3, lines 47-50 of Woolcock.

Applicant also argues that Marancik and Woolcock et al disclosed different process of forming the bars and it length, etc. It is noted that patentability of product-by-process claims is based on the product itself. The patentability of a product does not depend on its method of production. See *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) and *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Therefore, it is suggested claim 24 drawn to a product should be canceled because "product by process" claim is directed to the product per se, no matter how such a product was made. It has been well established by the

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Courts that the patentability of the final product per se which must be determined in a “product by process” claim and not the patentability of the process, and that an old or obvious product by a new method is not patentable as a product, whether claimed in “product by process” form or not (See also MPEP §2113).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donghai D. Nguyen whose telephone number is (571)-272-4566. The examiner can normally be reached on Monday-Friday (9:00-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Peter D. Vo can be reached on (571)-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DN
March 29, 2006


MINH TRINH
PRIMARY EXAMINER